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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/876,704

Filing Date: June 07, 2001

Appellant(s): MROZINSKI ET AL.

William J. Bond
For Appellant

EXAMINER'S ANSWER

This is in response to the supplemental appeal brief filed 12/12/07 appealing from the Office action mailed 11/14/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,643,939	Sugiyama et al.	02-1987
6,492,307	Matsuo et al.	12-2002
6,533,119	Hansen et al.	03-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 4-7, 13-15, 18-20, 23-25, 29, 30 and 39-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuo et al. US 6,492,307.

Matsuo discloses a personal cleansing sheet comprising an aqueous cleansing liquid retention layer **2** laminated on one side of an oily substance absorption layer **1** (see Figs. 1-2; and column 2, lines 29-39). Oily substance absorption layer is made of

thermoplastic resins including polyolefin and polypropylene resins (column 3, lines 4-10). Matsuo further discloses the oil substance absorption layer has a porosity (void volume) of about 5 to about 50%, and thickness of about 20 to about 300 μm (column 3, lines 40-46; and column 4, lines 62-64). Oily substance absorption layer can further comprise non-particulate additives such as silicone oils, liquid paraffin or polyethylene wax in an amount of at least about 5% (column 3, lines 15-20 and 56-60). The aqueous cleansing liquid of the cleansing liquid retention layer can be any known lotion, cleansing liquid, emulsion, or the like (additive that benefit the skin or hair) (column 6, lines 33-38). The cleansing liquid retention layer further comprises insoluble particulate powders having average particle size of about 1 to about 30 μm (column 6, lines 39-61).

Regarding the limitations of interstitial volume, degree of transparency, and average pore size of the oil absorption layer, it is the position of the examiner that the oil absorption layer taught by Matsuo would have the same interstitial volume, transparency, as well as the pore size, because Matsuo teaches the use of the same thermoplastic polymer, manufactured from fiber having the same basis weight and the same fiber diameter, *e.g.*, polyolefin and polypropylene resins using fiber having basis weight of about 20 to about 55 g/m^2 , and fiber diameter of about 0.1 to about 10 μm (column 4, lines 39-56). Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, where the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4-7, 13-15, 18-20, 23-25, 29, 30 and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al. US 6,492,307, in view of Hansen et al. US 6,533,119.

Matsuo is relied upon for the reason stated above. Regarding to the properties of the oil absorbing layer, it would have been obvious to one of the skill in the art that the oil absorbing layer taught by Matsuo would have the claimed properties, because Matsuo teaches the use of the same thermoplastic polymer. However, to be more specific, Hansen teaches oil absorbing wipes made of porous sheet thermoplastic polymer such as polyolefin and polypropylene having fiber average diameter of less than 10 μm , void volume of from 40 to 80%, average pore size of 3-15 μm , and oil absorption capacity of from 0.7 to 6 mg/cm^2 (column 4, lines 25-62). Hansen further

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teaches the wipes having transparency of about 65% or less, having Hand of 8g or less, and having the ability to change from opaque to translucent after absorbing oil (column 5, lines 1-27).

Claims 26-28, 31-33, 35-38, 45-53 and 55-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al. US 6,492,307, in view of Kondo et al. WO 99/29220.

Matsuo is relied upon for the reason stated above. Matsuo does not expressly teach the claimed method.

Kondo teaches a process for applying a coating composition to an oil absorbing sheet comprising applying to a surface to the oil absorbing sheet a coating solution containing fine particles of liquid-absorbing substance, solvent, and surfactant; and drying the coating to remove the solvent therefrom (page 9, lines 13-30). Therefore, one of ordinary skill in the art would have been motivated to use the process of Kondo to prepare the cleansing sheet of Matsuo, because Matsuo teaches coating the oily absorption sheet with a film, and because Kondo teaches the oily absorption sheet can be coated by applying a coating solution to the surface of the sheet to obtain an oil cleaning sheet that has excellent oil absorption and resistant to damage during use.

Claims 1, 4-9, 12-15, 18-33, 35-53 and 55-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. WO 99/29220, in view of Sugiyama et al. US 4,643,939.

Kondo teaches a process for applying a coating composition to an oil absorbing sheet comprising applying to a surface to the oil absorbing sheet a coating solution containing fine particles of liquid-absorbing substance, solvent, and surfactant; and drying the coating to remove the solvent therefrom (page 9, lines 13-30). Surfactant includes polyvinyl alcohol (page 10, lines 28-30). Oil absorbing sheet comprises porous plastic film sheet, e.g., polypropylene, polyethylene; and about 20-60% fillers, e.g., mineral oils (page 6, lines 20-30). The porous film sheet has interstitial volume in the range of $0.0001\text{-}0.005\text{ cm}^3$, void content in the range of 5-50%, the thickness in the range of $5\text{-}200\mu\text{m}$, and oil absorption per unit of up to 3.78 mg/cm^2 (pages 5, 8, and 14-22). Kondo does not specifically teach the transparency of the porous plastic film sheet being of less than 65 percent. However, Kondo teaches excellent transparency, notable transparency enabling easy confirmation of oil absorption (page 8, lines 29-31; and examples). Accordingly, it is the position of the examiner that the oil absorption layer taught by Kondo would have the claimed transparency, because Kondo teaches the use of the same thermoplastic polymer for the same purpose. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, where the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

It is noted that Kondo does not teach the use of additive in the coating solution.

Sugiyama teaches a coating solution comprising solvent, bactericide such as salicylic acid; and water-soluble sizing agent, such as polyvinyl alcohol for oil absorbing cosmetic wipes (abstract; and column 2, lines 30-68). Thus, it would have been obvious to one of ordinary skill in the art to modify the coating solution of Kondo to include the bactericide in view of the teaching of Sugiyama to obtain the claimed invention, because Sugiyama teaches oil absorbing wipes containing bactericide exhibits better cosmetic effect than the conventional oil absorbing wipes (column 4, lines 17-23), because Sugiyama teaches bactericide contained in the oil absorbing wipes suppressed proliferation of bacteria therefore, reduce adverse effects of bacteria on the skin, and because Kondo teaches the use of a wide variety of additives may be added to the coating solution (page 10, lines 10-11).

It is further noted that Kondo does not teach the viscosity of the coating solution. However, it would have been obvious to one of ordinary skill in the art to, by routine experimentation determine a suitable viscosity of the coating solution, because Kondo teaches a coating solution that provides a hydrophilic property in the film surface along with a safety to the skin, and good capability of liquid absorption.

Claims 10 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. WO 99/29220, in view of Sugiyama et al. US 4,643,939 and Park et al. US 5,939,093.

Kondo and Sugiyama are relied upon for the reason stated above. The references do not explicitly teach the use of polyvinyl pyrrolidone.

Park teaches a cosmetic pack in the form of sheet comprising polyvinyl pyrrolidone (abstract; and column 3, lines 30-42). Thus, it would have been obvious to one of ordinary skill in the art to modify the coating solution of Kondo to use polyvinyl pyrrolidone in view of the teaching of Park, because Kondo teaches the use of polyvinyl alcohol, and because Park teaches the equivalency of polyvinyl alcohol and polyvinyl pyrrolidone as a water-soluble polymer useful to enhance the strength of the film and to maintain clean and healthy skin (id).

(10) Response to Argument

Claims 1, 4-7, 13-15, 18-20, 23-25, 29, 30 and 39-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuo et al. US 6,492,307.

Appellant argues that the active containing layer taught by Matsuo is not made of a film-forming polymer.

However, it is noted that Matsuo teaches the aqueous cleansing liquid retention layer **2** (the active containing layer) is made of polyurethane, acrylic, polyester, or polyamide (column 5, lines 59 through column 6, lines 1-28). Polyurethane and polyester are well known in pharmaceutical art as film forming polymer¹. Accordingly, Matsuo does teach an active containing layer made of a film-forming polymer.

Appellant argues that Matsuo does not teach the porous oil absorbing layer is one that has a transparency of less than 65 percent and changes transparency upon absorption of oil.

However, it is the position of the examiner that the oil absorption layer taught by Matsuo would have the same interstitial volume, transparency, as well as the pore size,

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because Matsuo teaches the use of the same thermoplastic polymer, manufactured from fiber having the same basis weight and the same fiber diameter, *e.g.*, polyolefin and polypropylene resins using fiber having basis weight of about 20 to about 55 g/m², and fiber diameter of about 0.1 to about 10 μ m (column 4, lines 39-56). Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, where the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Furthermore, Matsuo also teaches the oily substance absorption layer 1 will change transparency upon absorption of oil to make it is easier to visually confirm that sebum/oily soil has been absorbed (column 5, lines 6-22, and 36-46).

Claims 1, 4-7, 13-15, 18-20, 23-25, 29, 30 and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al. US 6,492,307, in view of Hansen et al. US 6,533,119.

Claims 26-28, 31-33, 35-38, 45-53 and 55-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al. US 6,492,307, in view of Kondo et al. WO 99/29220.

Appellant argues that the rejections over Matsuo alone or in combination with Kondo or Hansen are simply not understood, because Matsuo does not teach a film forming polymer coating.

However, as discussed above, Matsuo teaches a coating layer made of a wide variety of polymer including polyurethane and polyester (ID). It is well known in pharmaceutical art to use polyurethane or polyester as a film-forming polymer ¹ (this footnote reference is used as a teaching reference only. This is not a new rejection).

Appellant argues that the rejection of method claims 45-53 and 55-61 is not understood, because the claims require the film forming polymer form a coating on a given face of the porous substrate where the coating does not penetrate through the porous substrate to the opposite face of the porous substrate in order to adequately function as an oil absorbing material. Appellant further indicates that this is a problem not addressed in the prior art nor does the prior art provide a solution to this problem.

However, appellant's attention is called to column 7, lines 10-33, Matsuo teaches to prevent the aqueous cleansing liquid contained in the aqueous cleansing liquid retention layer **2** from seeping into the oily substance absorption layer **1**, a liquid impermeable layer **3** is laminated between layers **1** and **2**. Accordingly, Matsuo does teach a coating layer that does not penetrate through the porous substrate to the opposite face of the porous substrate.

Claims 1, 4-9, 12-15, 18-33, 35-53 and 55-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. WO 99/29220, in view of Sugiyama et al. US 4,643,939.

Appellant argues the rejection over Kondo in combination with Sugiyama is not understood, because Sugiyama teaches a bactericide incorporated into the oil-absorbing sheet, but not in the coating as claimed by the present claimed invention.

Contrary to the appellant's argument, Sugiyama teaches a coating composition comprising a bactericide, a solvent, and a water soluble sizing agent including polyvinyl alcohol, starch, carboxymethyl cellulose, or hydroxypropyl cellulose (column 2, lines 55-68). According to the present claimed invention, see for example independent claim 1, recites "said coating covering the porous substrate second face and comprising a film forming polymer with at least one additional additive". Sugiyama meets all the requirement of this limitation, that is a coating composition comprising film-forming polymer such as polyvinyl alcohol, starch, carboxymethyl cellulose, or hydroxypropyl cellulose ¹, and an additive. Accordingly, it would have been obvious to one of ordinary skill in the art to modify the coating of Kondo using the coating in view of the teaching of Sugiyama, because Sugiyama teaches oil absorbing wipes containing bactericide exhibits better cosmetic effect than the conventional oil absorbing wipes (column 4, lines 17-23), because Sugiyama teaches bactericide contained in the oil absorbing wipes suppressed proliferation of bacteria therefore, reduce adverse effects of bacteria on the skin, and because Kondo teaches the use of a wide variety of additives may be added to the coating solution (page 10, lines 10-11).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/S. Tran/
Primary Examiner
Art Unit 1618

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